

## REMARKS

Claims 1-9 and 15-24 were pending of which Claims 1, 2, and 7-9 were rejected and Claims 3-6 were objected to. Claims 21-24 were indicated as being allowable. Claims 15-20 were subject to a restriction and/or election requirement and were withdrawn from consideration by the Examiner. No claims have been amended or cancelled.

### Election/Restrictions

The Examiner stated that Claims 15-20 are directed to an invention that is independent or distinct from the invention originally claimed. The Examiner constructively elected Claims 1-9 and 21-24 and withdrew Claims 15-20 from consideration as being directed to a non-elected invention. Applicants provisionally elect Claims 1-9 and 21-24 with traverse.

The Examiner stated that Claims 1-9, 21-24 and Claims 15 have a combination/subcombination relationship and that an election/restriction is proper under a two part test under MPEP§806.05(c). The Examiner stated that the first part of the test is satisfied as “the combination as claimed does not require the particulars of the subcombination as claimed because claims 1-9 and 21-24 do not require the particulars of ‘holding the wafer in a stationary position’/‘without moving the wafer’ as recited in claim 15.” The Examiner also stated the second part of the test is satisfied as “[t]he subcombination has separate utility such as for inspections (e.g., mapping, resistivity) other than film thickness.”

Claim 1 recites “positioning a wafer at a fixed station” and “moving the optical system relative to the wafer” and Claim 21 recites “providing lateral movement of the optical system with respect to the wafer”. Claim 15 recites “holding the wafer in a stationary position” and “moving an optical system rotationally relative to the wafer”. Applicants submit in Claims 1, 21 and in Claim 15 the optical system moves relative to the wafer. Thus, Claims 1, 21 and Claim 15 do not have a combination/subcombination relationship as suggested by the Examiner.

Moreover, Applicants submit that the Examiner’s statement that “[t]he subcombination has separate utility such as for inspections (e.g., mapping, resistivity) other than film thickness” is incorrect. Claim 1 specifically recites “moving the optical system relative to the wafer to inspect a plurality of separate inspection areas on the wafer” (emphasis added) and Claim 21 recites “to inspect a plurality of separate inspection areas on the wafer”. Applicants note that neither Claims 1, 21 nor Claim 15 (nor any of their dependent claims) specifically recite “inspections (e.g., mapping and resistivity)”. The Examiner has not

provided, and Applicants are aware of no reason that the utility of Claims 1, 21 and Claim 15 should be separate. Thus, it is incorrect to assign a separate utility to Claim 15.

Accordingly, Applicants submit that neither part 1 or part 2 of the two part test have been satisfied. Reconsideration and withdrawal of this Election/Restriction is therefore respectfully requested.

#### Claim Rejections – 35 U.S.C. §102

Claims 1, 7, and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by Cheng (5,546,179) (“Cheng ‘179”). The Examiner stated that “Cheng ‘179 discloses (Fig. 2) placing a wafer at a fixed chuck (64)....” Applicants respectfully traverse.

In the description of Fig. 2, Cheng ‘179 states “[I]n step 64, a wafer 22 is placed on chuck 16 as described in reference to Fig. 1.” Col. 7, lines 17-19. Referring to Fig. 1, Cheng ‘179 expressly teaches the use of a chuck assembly 12 that includes a “rotatable chuck 16.” Col. 5, lines 15-16. Thus, contrary to the stated rejection, chuck 16 is not “fixed”.

In the Response to Arguments section, the Examiner stated that Claim 1 reads on Cheng (‘179) col. 7, lines 65-65 entire chuck assembly (12). The cited section, however, merely states that the “testing and processing can be performed directly after the mapping and finding of the index marks without having to move the wafer 22 to a different testing chuck or station.” In other words, the wafer need not be moved from one station to the next for testing and processing. The cited section does not refer to “positioning a wafer at a fixed station” as recited in Claim 1.

Accordingly, Claim 1, which recites “positioning a wafer at a fixed station” is not taught or suggested in Cheng ‘179.

Thus, Applicants respectfully submit that Claim 1 is patentable over Cheng ‘179. Reconsideration and withdrawal of this rejection is respectfully requested. Claims 2-9 depend from Claim 1 and are, therefore, likewise patentable.

#### Claim Rejections – 35 U.S.C. §103

Claims 1-2 and 7-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cheng (6,164,894) (Cheng ‘894). The Examiner stated that “Cheng ‘894 teaches positioning (and then testing) a wafer in a fixed station (16) (col. 1 line 55-col. 2 line 25)”. Applicants respectfully traverse.

At col. 1, line 55 to col. 2, line 17, Cheng '894 describes the problems associated with "the prior art method" which requires that the wafer be "transported from the edge mapping platform to a different test chuck for testing or processing." The "prior art method" is described by Cheng '894 at col. 1, lines 44-54. Notably, Cheng '894 states that the "wafer is positioned on a rotatable platform, where the edge of the wafer is positioned within or over a sensor. The platform is rotated, and the position of the edge of the wafer is detected by the sensor throughout the entire 360-degree rotation." Col. 1, lines 44-48.

Thus, Cheng '894 is not describing a system where the wafer is at a "fixed" position. In addition, Cheng '894 goes on to describe the chuck assembly 16 in Fig. 1, stating that "the chuck 84 is rotatable about a central z-axis". Thus, contrary to the stated rejection, chuck in Cheng '894 is not "fixed".

In the Response to Arguments section, the Examiner stated that Claim 1 reads on "Cheng ('894) Fig. 6 (214) platform (82) chuck assembly (16)." However, Cheng '894 at Fig. 6 (212) states "rotate wafer and map edge of wafer". Applicants do not understand the Examiner's reference to "platform (82) and chuck assembly (16)". To the extent that the Examiner intends to indicate that the platform (82) is a "fixed station", Applicants point out that Claim 1 recites "moving the optical system to follow the edge of the wafer and locate an alignment feature on the edge of the wafer" and "moving the optical system relative to the wafer to inspect a plurality of separate inspection areas on the wafer", which Cheng '894 does not teach or suggest.

Accordingly, Claim 1 is not taught or suggested in Cheng '894.

Thus, Applicants respectfully submit that Claim 1 is patentable over Cheng '894. Reconsideration and withdrawal of this rejection is respectfully requested. Claims 2-9 depend from Claim 1 and are, therefore, likewise patentable.

Claims 1-9 and 15-24 remain pending. For the above reasons, Applicants respectfully request allowance of Claims 1-9 and 15-24. Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 982-8202.

**Via Express Mail Label No.  
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Respectfully submitted,



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